

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Cuc Hong
Application No.: 09/991,388
Filing Date: Nov. 15, 2001
Title: DIGITAL PHOTO ALBUM STORAGE DEVICE

Confirmation No.: 3280
Examiner: Liu, Ming Hun
Group Art Unit: 2675



Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 24, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$110.00
() two months	\$420.00
() three months	\$950.00
() four months	\$1480.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Typed Name: Vaughn W. North

Signature:

Respectfully submitted,

Cuc Hong

By

Vaughn W. North

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Date: August 24, 2004

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PATENT APPLICATION
Docket No. 10019661-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

Cuc Hong

Serial No.: 09/991,388

Filed: November 15, 2001

Art Unit 2675

For: **DIGITAL PHOTO ALBUM STORAGE DEVICE**

Examiner: Ming Hun Liu

BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants filed a timely Notice of Appeal from the action of the Examiner in finally rejecting all of the claims in this application dated June 24, 2004. This brief is being filed under the provisions of 37 C.F.R. § 1.192. The filing fee of \$330.00, as set forth in 37 C.F.R. § 1.17(c) for a large entity, should be charged to deposit account 08-2025.

CERTIFICATE OF DEPOSIT

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on August 24, 2004.

~~Respectfully submitted,~~

John W. Vaughn
Vaughn W. North, Reg. No. 27,930

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REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Company, by way of assignment from Cuc Hong, who is the named inventor and is captioned in the present brief. The assignment documents were recorded at Reel No. 012741, Frame 0501 in the United States Patent and Trademark Office on November 5, 2001

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-22 are pending and appealed in the present application.

STATUS OF AMENDMENTS

An amendment dated April 26, 2004 was submitted after final rejection but was not entered by the Examiner.

SUMMARY OF INVENTION

The present invention is directed to an improved digital photo album storage device. Compared to other digital photo albums, the present invention provides an economical and simplified method for storing, viewing, and sharing digital photographs.

The invention will be summarized with respect to Figure 2 of the application, reproduced below:

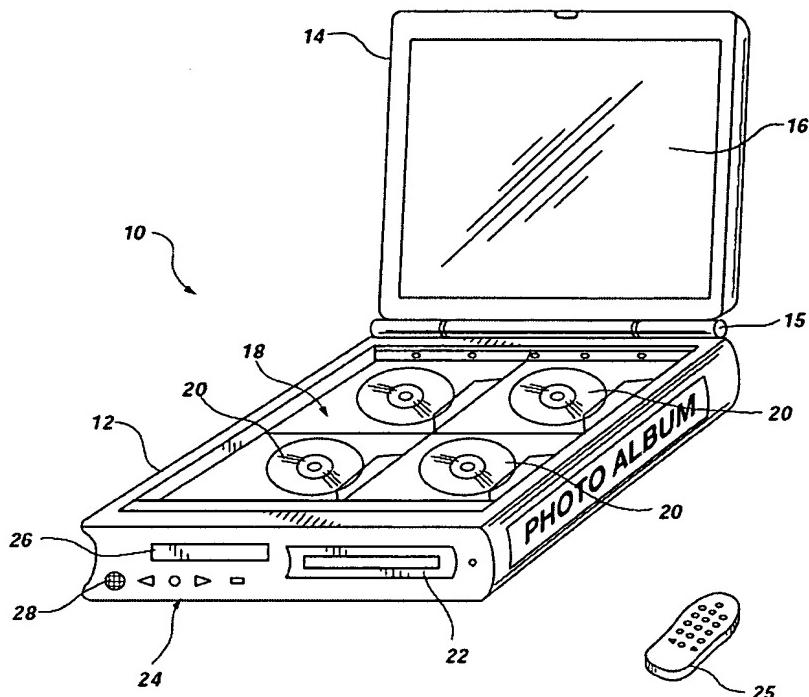


Fig. 2

The invention comprises a digital photo storage album system (10). This system can be used to conveniently and centrally store and view digital images contained on a variety of memory storage devices. The digital photo storage album system (10) comprises a display cover (14) used to cover a lower storage housing (12) when not in use. When the display cover (14) is released from a storage mode, a visual display device (16) can be exposed to the user. The display cover (14) can be hingedly coupled to the lower storage housing (12) at hinge (15). (See Page 4, Lines 3-15.)

A storage cavity (18) can be located in the lower storage housing (12) to provide storage area for a plurality of removable digital memory storage devices (20). The removable digital memory storage devices (20) can be optical disks such as CD or DVD disks, or alternatively can include floppy disks, flash memory cards, or other digital storage media. (See Page 19, Lines 19-23.)

An electronic processing device (30) (shown in alternate embodiment Figure 3b below) is provided to receive the removable memory storage devices (20) and process and display the digital images contained on the storage devices on the visual display (16). A portal (22) can be configured as an interface to enable the digital photographs stored on the removable digital memory storage device (20) to be transferred to the electronic processing device (30) and sent to the visual display device (16). (See Page 4, Lines 26-30.)

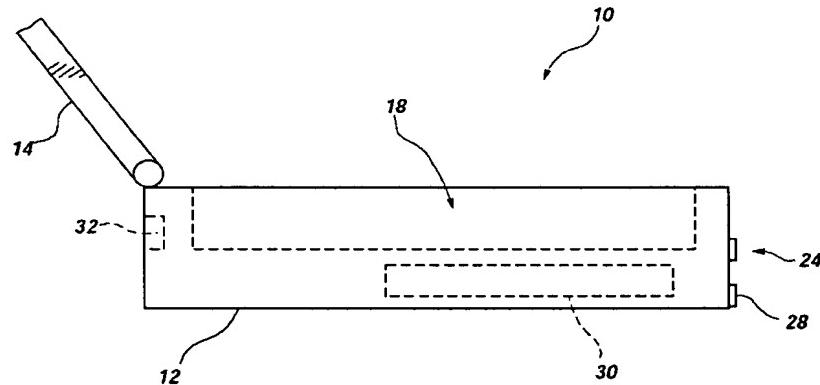


Fig. 3b

Navigation data entry interface keys (24) can be used to allow a user to navigate through images stored on the removable memory storage devices (20). The navigation data interface can be used to select a particular image from the removable storage device for viewing on the display screen. It can also be used to manipulate the digital image displayed on the visual display device (16) to zoom, pan, etc. A remote navigation data interface (25) can be used to remotely navigate through the image data. (See Page 4, Line 30 – Page 5 Line 4.)

An image information display (26) can display information relating to names and sizes of the data files contained on the removable memory storage devices (20). The

image information display (26) can facilitate the user in navigating through the image data contained on the removable memory storage devices (20). (See Page 5, Lines 5-9.)

A transfer device (32) (Fig. 3) can be used to connect the digital photo storage album system (10) to a remote user or to the internet. The transfer device (32) can enable the user to share the digital images on the removable memory storage devices with other remote users. Also provided is a telephone communication system, including a speaker phone (28) which can allow multiple, remotely located users to discuss the image being viewed. (See Page 5 Lines 10 – 13.)

ISSUES

I. Whether the subject matter defined by claim 1 would have been obvious over U.S. Patent No. 5,572,399 to Shirato et al. (hereinafter “Shirato”) to a person of ordinary skill in the art of the subject matter at the time of the invention.

II. Whether the subject matter defined by claims 1-22 would have been obvious over U.S. Patent No. 5,109,354 to Yamashita et al. (hereinafter “Yamashita”) in view of U.S. Design Patent No. D446,809 to Parker (hereinafter “Parker”) to a person of ordinary skill in the art at the time of the invention.

GROUPING OF CLAIMS

Claims 1 – 7 stand or fall together. Claims 8 – 13 stand or fall together. Claims 14 – 22 stand or fall together.

ARGUMENT

I. The Subject Matter of Claim 1 Would Not Have Been Obvious over Shirato

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shirato. For the reasons that follow, Appellants respectfully submit that the subject matter of these claims would not have been obvious to a person of ordinary skill in the art at the time of the invention.

Independent claim 1 reads as follows:

1. A container configured to electronically display images and simulate a photo album storage device, comprising:
 - a portable storage housing having a bottom and a plurality of upwardly extending sides, the upwardly extending sides defining at least one storage cavity portion within the storage housing, the at least one storage cavity portion being configured to concurrently store a plurality of removable digital memory storage devices;
 - a display cover coupled to the storage housing, the cover including a visual display device and being configured for open and closed positions to directly cover the storage cavity portion of the storage housing when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode; and
 - an electronic processing device, separate from the storage cavity portion and coupled to the storage housing and the visual display device, the processing

device being configured to accept at least one of the plurality of removable memory storage devices and to process and display digital image data contained on the storage device.

A useful shorthand version of this claim is as follows:

A container configured as (i) a photo album for electronically displaying photo images comprising a housing with a storage cavity for storing removable memory devices, (ii) a display cover having a visual display device and open and closed position that directly expose or cover the storage compartment and (iii) a processor separate from the storage compartment, to process digital images for the visual display device.

The Examiner apparently believed that all the limitations in Claim 1 were met by Shirato. Figure 4 of Shirato is exemplary of the disclosure of Shirato and is reproduced below:

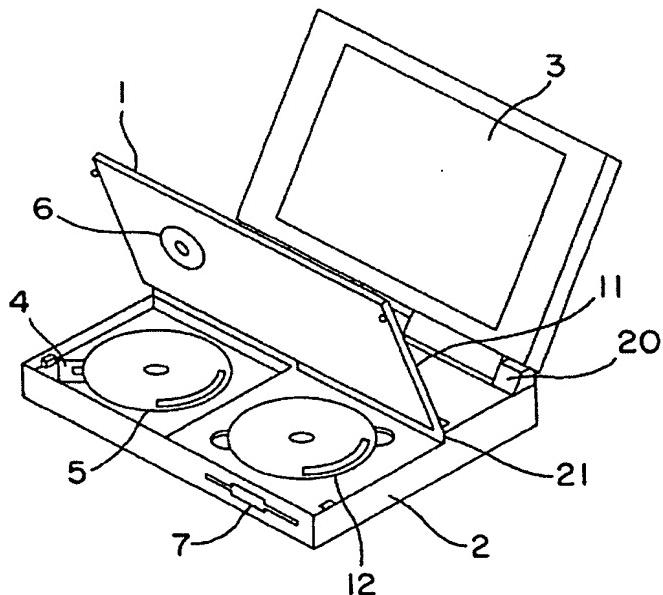


FIG. 4

In Figure 4 of Shirato, a keyboard arrangement 1 having keys 11 is positioned above a body 2. The keyboard arrangement can be moved between a first position where the keyboard arrangement 1 conceals the loading face 8 (not shown, located underneath 5) of the CD-ROM device 4 so that the medium disk 5 can be loaded or unloaded by an operator. On the top plate of the apparatus, at least one storage place 12 is provided for a medium disk with or without a holding package. On the bottom plate of the keyboard arrangement 1, a clamping means 6 is fixed. The clamping means 6 is positioned to correspond to the center of the medium disk 5 loaded on the CD-ROM device 4. When the keyboard arrangement 1 is at the first position, an iron plate (not shown) within the clamping means 6 is attracted by a magnet within the CD-ROM device 4. This magnetic attraction allows the resin member within the clamping means 6 to apply pressure to the medium disk 5. The medium disk 5 is thus loaded in the CD-ROM device 4 so that the medium disk 5 can be driven at a high speed. Accordingly, Shirato discloses that there is no need for a tray or caddy mechanism for loading or unloading the medium disk in the invention. (See Shirato, Col. 2, Line 42 to Col 3, Line 26.)

A. The Disclosure of Shirato Fails To Meet The Limitations of Claim 1

The Examiner apparently believed that all the limitations of claim 1 are met by Shirato and that the present invention was merely lacking the keyboard arrangement of Shirato. The Examiner states in the Advisory Action that “[t]he removal of a portion of the keyboard to yield a storage space results in an invention similar to the claimed invention. The Examiner cites *In re Karlson*, 22 CCPA 1088 as finding that “the

elimination of an element and its function is a valid modification.” (See Advisory Action, Continuation Sheet.) The citation is vague and unclear as written.

The Court of Customs and Patent Appeals held in *In re Karlson* that “omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before.” *In re Karlson*, 50 C.C.P.A. 908, 911 (C.C.P.A., 1963). The elimination of the keyboard in Shirato, and its function of providing a clamping member to supply pressure to the medium disk to allow the disk to be driven at high speed, necessarily changes the function of the remaining elements in the Shirato disclosure. Shirato discloses that the invention “does not need a tray or caddy mechanism for loading or unloading the medium disk.” (Shirato Col 3 Lines 20-21). Without the keyboard and associated clamping member disclosed in Shirato, there could be no CD-ROM device as disclosed in Shirato. Without a “tray or caddy mechanism for loading or unloading the medium disk” there could be no CD-ROM device at all, and hence no reason to store CDs. The removal of the keyboard would change the function of the device disclosed in Shirato, and hence, fail to meet the obviousness test laid out in *In re Karlson*.

Further, claim 1 of the present invention provides “...a display cover coupled to the storage housing...to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode.” By exposing the storage cavity when the digital photo storage album is in an open, viewing mode, it enables a user to display digital photo image data from a digital photo memory storage device while simultaneously accessing and reviewing other digital photo memory storage

devices in the storage area. The ability to concurrently view both the viewing screen and the digital photo memory storage devices in the storage area is a key inventive step in the present invention. In the Shirato device, the keyboard unit 11 must be closed over the CD-ROM device 4 so that the clamping means 6 applies pressure to the medium disk 5 enabling it to be driven at a high speed. (See Shirato column 3, lines 10-20). Thus, the Shirato device does not allow access to the storage area during the display of the photo images from a digital memory storage device.

It is useful to keep in mind some of the purposes for the limitations discussed above in the context of the invention. The digital photo album device has been specifically designed to be a viable alternative to an actual photo album. As such, it must be inexpensive and operable by persons having a low technical literacy level. Specifically, the operation of the current invention is similar to a traditional photo album having nothing more than photos stored in a book-like cover. The user simply opens the cover and presses a button to display photos. The storage compartment (FIG. 2) is in full view. The user selects the desired disc and inserts it in the slot 22. No other user functions are required.

Shirato, on the other hand, discloses a computer having a keyboard covering a storage area. To access the storage area, operation of the CD-ROM device must be halted and the keyboard must first be raised. This added complexity would add unnecessary expense and would likely be daunting to those having a low technical literacy level. The device in the present invention was specifically designed such that the storage cavity is accessible to a user, allowing the user to file through the digital memory storage devices while simultaneously viewing the digital content of the storage devices.

The device in the present invention was further designed to be inexpensively manufactured to enable a user to purchase the device without going to the expense of purchasing an entire computer, such as the one disclosed in Shirato. This simplicity is visually conveyed by the “photo album” appearance of the housing. Much of the older consumer population “freezes” at the sight of a computer. The claims of the present invention include the limitation that the housing simulates a photo album, such as the traditional photo album assembled in book form. This is expressly set forth in the preamble and carried into the claimed elements by antecedent reference. See, for example, line 1 of the preamble identifying “a container configured to electronically display images and simulate a photo album storage device.”

A preamble can be given the effect of a limitation if it breathes life and meaning into the claim. See *MPEP* § 2111.02. In order to limit the claim, the preamble must be “essential to point out the invention defined by the claim.” *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present invention, the preamble recites a container in the preamble. The first element of claim 1 discloses a portable storage housing. The second element of claim 1 discloses a display cover. The third element of claim 1 discloses an electronic processing device. While the elements of the claim describe portions of the container, the preamble is essential to point out that the invention is a container configured to electronically display images and simulate a photo album storage device. Thus, the preamble breathes life and meaning into the claim. Therefore, the preamble is found to be limiting to the claim.

The feature of a container configured to display images in a simulated photo album is carried into the body of the claim by the listed components of the container

along with express references throughout the claim to storage, display, and image terminology. It is clear that none of the cited art suggests that an electronic photo display device be configured with the appearance of a conventional photo album. Yet this functional limitation is very significant to successful perception of this device by those having a low technical literacy. To minimize the cost of manufacture, the device of the present invention was minimally designed to have only the functions necessary to view the content of the digital memory storage devices.

Claim 1 of the present invention further defines “a display cover coupled to the storage housing, the cover including a visual display device and being configured for open and closed positions to directly cover the storage cavity portion of the storage housing when in a closed storage mode.” The display cover is further configured to “directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode.”

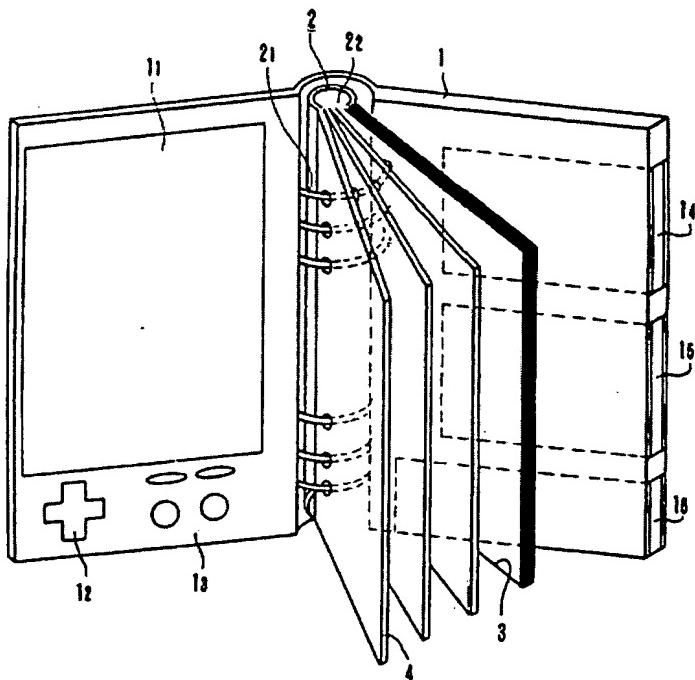
As previously stated, the display cover in the present invention is designed to simulate a photo storage album. When the display cover is closed it will “directly cover the storage cavity portion” just as a traditional photo album cover does. When the display cover is opened it will “directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices” just as a traditional photo album exposes photographs when the cover is opened. Opening the display cover will also “directly expose the visual display device at a viewing position”. This again simulates a traditional photo album by enabling a user to view the digital photos when the cover is opened.

The Shirato reference fails to teach or suggest these limitations when viewed without the benefit of hindsight. Therefore, the Examiner's rejection of claim 1 as being unpatentable over Shirato should be overturned.

II. The Subject Matter of Claims 1-7 Would Not Have Been Obvious over Yamashita in view of Parker

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita in view of Parker. For the reasons that follow, Appellants respectfully submit that the subject matter of these claims would not have been obvious to a person of ordinary skill in the art at the time of the invention.

The Examiner states in the final rejection that the Yamashita invention is nearly identical to the claimed invention, with only the intended use differing. Figure 1 of Yamashita is exemplary of the disclosure and is reproduced below:



F I G. 1

In Figure 1 of Yamashita, a portable electronic system pocketbook 1 is shown having a foldable structure composed of left and right portions connected together by a spine portion, a display unit 11, a cursor key 12, function keys 13, and integrated circuit cards 14 and 15. An expansion card holder 2 comprises rings 21 for holding an expansion card 4 and/or recording paper 3 and an opening/closing metal piece 22 for opening /closing the rings 21. Communication between the expansion card 4 and the main body 1 is performed by a variety of communicating means. (See Yamashita Col 3 Lines 12-30.)

1. The Subject Matter of Claims 1-7 Would Not Have Been Obvious over Yamashita in view of Parker

A. *Combining The Ornamental Designs in Parker With The Disclosure of Yamashita Fails To Meet The Limitations of Claim 1*

In the final rejection dated February 25, 2004, the Examiner stated that “Yamashita’s invention is nearly identical to the claimed invention however the intended use differs slightly from the applicant’s invention. Namely, the applicant claims a photo album where the reference does not.” (See Final Rejection, Page 3, Paragraph 5).

Applicant questions how the fundamental character of the invention being a photo album can be referred to as a mere “slight difference”.

Indeed, the device disclosed in Yamashita is in fact an electronic pocketbook with a rudimentary design for planning and scheduling. In contrast, the present invention displays images or photos – a very different function than providing dates and data

display. Second, Yamashita fails to teach or disclose an electronic processing device, separate from the storage cavity.

To put the limited scope of meaning of the Yamashita device in perspective, when the Yamashita patent was filed in the first quarter of 1990, desktop computers using Microsoft DOS couldn't use more than 640 kilobytes of RAM. It was six years prior to the shipment of the first Palm Pilot (April, 1996) and one year before Microsoft Windows 3.1 was released for desktop computers (April 1992). Needless to say, the electronic system pocketbook apparatus disclosed in Yamashita was not capable of functioning, nor was it designed to operate, as a digital photography display. Therefore, Yamashita has limited relevance to the display of photographic images and would be viewed by one of ordinary skill in the art as significant at the time of the present invention.

Furthermore, claim 1 of the present invention recites "a portable storage housing having a bottom and a plurality of upwardly extending sides". Figure 1 of Yamashita does not show a portable storage housing having a bottom, nor does it show a plurality of upwardly extending sides. This limitation is not disclosed in Yamashita. Instead, the invention in Yamashita depends upon rings 21 for storage, the rings being required "for holding an expansion card and / or recording paper". The rings are necessary since the plurality of upwardly extending sides in the present invention are not present in Yamashita.

Combining the disclosure of Yamashita with the ornamental design of Parker does not makeup for the limitations in Yamashita. Parker teaches the display of pictures; however, applicants concur that displaying digital pictures is not new. The patentability of claim 1, however, lies in the fact that there would have been no motivation, teaching,

or suggestion at the time the invention was made to combine these elements in the manner required by claim 1. “[V]irtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Therefore, the law requires an examiner to “show a motivation to combine the references that create the case of obviousness.” *Id.* “In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

The Examiner’s conclusion is inconsistent with the law in this respect. In the first place, the present invention addresses the problem of simplifying current computer technology to a configuration acceptable to a technically challenged customer base. The combined references have no relation to this issue. Furthermore, the final rejection does not single out a motivation that would have existed at the time of the invention for plucking the ornamental designs from Parker and combining them with elements from Yamashita so as to arrive at the subject matter defined by claim 1. The mere fact that Yamashita discloses a rudimentary organizer as the examiner states in the final rejection (page 4, paragraph 1), is not sufficient reason to combine the Yamashita disclosure with the ornamental design images in Parker.

B. Combining The Ornamental Designs in Parker With The Disclosure of Yamashita Fails To Meet The Limitations of Claims 2-7

In reference to claim 2, the Examiner states that the Yamashita disclosure includes a navigational pad for data manipulation in Figure 1. However, as stated in claim 2 of the present invention, the navigation data entry interface is configured to enable an operator to manipulate digital images, not merely data manipulation.

Therefore, the navigation data entry interface is necessarily configured differently from the navigation pad in Yamashita. Thus, claim 2 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

Claim 3 further includes a data transmission and reception system coupled to the electronic processing device of claim 1 and configured to allow a user to electronically send and receive data to and from the electronic processing device. The specification further clarifies in an example embodiment that the data transmission and reception system can be used to transmit image data to other device users. (See Page 4, Line 32 to Page 5, Line 1 and Lines 11-13). Neither the Yamashita disclosure nor the ornamental designs in Parker make a reference to transmitting or receiving data to other users.

The Examiner stated in the final rejection that Yamashita teaches that data transmission is conducted between the expansion card and the main CPU. (See Final Rejection, Page 4, Paragraph 3). However, Yamashita merely discloses sending data from an expansion card to the main body through internal circuitry. (See Yamashita Col. 3, Lines 27-30, and Col. 4, Line 47 to Col 5 Line 19). Thus, claim 3 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

Claim 4 further includes an image data information display to communicate to the user information relating to the digital images contained on the removable memory storage device contained in the processing device. In one example embodiment, the specification informs us that the image data information display can be used to show image file names and sizes. (See Page 5, Lines 5-9).

The Examiner states that Yamashita shows in Figure 1 a display used to show images from the storage media. As previously discussed, Yamashita is not configured to display images. Moreover, claim 4 is dependent on claim 1. Rejection of the dependent claim 4 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claim 1. The dependent claim, being narrower in scope, is allowable for at least the reasons for which the independent claim is allowable. Therefore, claim 4 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

Claim 5 further includes a plurality of storage compartments contained within the storage cavity of claim 1. Each of the storage compartments are configured to concurrently store a plurality of removable digital memory storage devices. Neither Yamashita nor Parker discloses a plurality of storage compartments, wherein each storage compartment is capable of concurrently storing a plurality of removable digital memory storage devices. Thus, claim 5 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

Claim 6 further includes a telephone communication system coupled to the storage housing of claim 1, and configured to be connectable to a telephone network to allow a user to telephonically communicate with others while viewing the digital image data displayed on the visual screen. The specification shows in an example embodiment that the telephone communication system can comprise the speaker phone 28 of Figure 1 of the present invention. (See Page 5, Lines 9-13).

The Examiner admits that neither Yamashita nor Parker disclose a telephone communication system. However, the Examiner claims that figure 5 of Parker shows a

SCSI adaptor and that a communication device can be connected to the SCSI adapter.

Neither Parker nor Yamashita discloses anything about connecting a telephone communication system to a SCSI adapter, or any other kind of adapter. Further, communication systems comprised of a speaker phone which can be connected through a SCSI adapter are not well known in the art, if they are known at all. Therefore, claim 6 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

Claim 7 further includes configuring the visual display device such that it can adopt a substantially vertical position when in an open, viewing mode. The Examiner fails to show that Yamashita's invention has a visual display device that can adopt a substantially vertical position when in an open, viewing mode. Rather, the angle of a visual display in a handheld device such as the one disclosed in Yamashita is usually dependent upon the person carrying said device. Therefore, claim 7 is patentable for the reasons set forth for independent claim 1 as well as for the additional reasons set forth above.

There is no motivation to combine components from Yamashita with the ornamental designs disclosed in Parker for the reasons discussed above for claims 2-7. Moreover, even the combination of Yamashita and Parker does not provide the components required by claims 2-7 in the relationship required by the claims and the Examiner has identified no motivation for doing so. The Examiner has failed to establish a *prima facie* case of obviousness for claim 2-7.

2. The Subject Matter of Claims 8-13 Would Not Have Been Obvious over Yamashita in view of Parker

Claims 8-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita in view of Parker. For the reasons that follow, Appellants respectfully submit that the subject matter of these claims would not have been obvious to a person of ordinary skill in the art at the time of the invention.

Independent claim 8 reads as follows:

8. A container configured to electronically display images and simulate a photo album storage device, comprising:
 - a portable storage housing having a bottom and a plurality of upwardly extending sides, the upwardly extending sides defining at least one storage cavity portion within the storage housing;
 - a plurality of storage compartments contained within the storage cavity portion, the storage compartments being configured to concurrently store a plurality of removable digital memory storage devices;
 - a display cover coupled to the storage housing, the display cover including a visual display device for displaying digital images and being configured for open and closed positions to directly cover the storage cavity portion of the storage housing when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode;
 - a electronic processing device, coupled to the storage housing and the visual display device, the processing device being configured to accept at least

one of the plurality of removable memory storage devices and to process and display digital image data stored on the memory storage devices;

a navigation data entry interface and navigation control circuitry, each operatively coupled to the processing device to enable an operator to manipulate the digital images stored on the at least one removable memory storage device contained in the processing device;

a data transmission and reception system coupled to the electronic processing device, the transmission and reception system being configured to allow a user to electronically send and receive data to and from the electronic processing device; and

a telephone communication system, coupled to the storage housing, the communication system being configured to be connectable to a telephone network to allow a user to telephonically communicate with others while viewing the digital image data displayed on the visual display screen.

Independent claim 8 provides additional limitations, but substantially includes the elements of claims 1, 2, 3, 5, and 6 including the limitation relating to being configured to simulate a photo album. Therefore, the arguments above for claims 1, 2, 3, 5, and 6 apply with respect to claim 8 and are herein incorporated by reference. Accordingly, the combination of the elements in these claims, as shown in claim 8, clearly differentiates the present invention over the prior art cited by the Examiner.

Claims 9 and 10 further include a navigation data entry interface with at least one touch key button and a touch screen interface on the visual display device. Claims 9 and 10 are dependent on claim 8. Rejection of the dependent claims 9 and 10 should be

reconsidered and withdrawn for at least the reasons given above with respect to the independent claims 1 and 8. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claims are allowable.

Claim 11 further includes a remote navigation device in data communication with the navigation control circuitry. The remote navigation device is configured to enable a user to remotely navigate through the digital image data displayed on the visual display device. One embodiment of the remote navigation device 25 can be seen in Figure 2 of the present invention. Neither Yamashita nor Parker discloses a remote navigation device. The Examiner claims that a remote device can be connected to the device in Parker disclosed in figure 5. However, the mere fact that a device can be connected does not mean that it would be obvious to do so. Therefore, claim 11 is patentable for the reasons set forth for independent claims 1 and 8 as well as for the additional reasons set forth above.

Claim 12 further includes storage sleeves hingedly coupled within the storage compartment. Claim 12 is dependent on claim 8. Rejection of the dependent claim 12 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claims 1 and 8. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claims are allowable.

Claim 13 further includes the elements of claim 7. The same arguments given for claim 7 apply with respect to claim 13.

There is no motivation to combine components from Yamashita with the ornamental designs disclosed in Parker for the reasons discussed above for claims 8-13. Moreover, even the combination of Yamashita and Parker does not provide the

components required by claims 8-13 in the relationship required by claims 8-13 and the Examiner has identified no motivation for doing so. The Examiner has failed to establish a *prima facie* case of obviousness for claim 8-13.

3. The Subject Matter of Claims 14-22 Would Not Have Been Obvious over Yamashita in view of Parker

Claims 14-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita in view of Parker. For the reasons that follow, Appellants respectfully submit that the subject matter of these claims would not have been obvious to a person of ordinary skill in the art at the time of the invention.

Independent claim 14 reads as follows:

14. A container configured to simulate a photo album storage device and to electronically display images, comprising:
 - an electronic data processing device configured to process and display digital image data;
 - a portable case encompassing the electronic data processing device, comprising upwardly and outwardly extending walls which extend vertically above and laterally beyond the electronic processing device to define a storage cavity;
 - a plurality of storage compartments, separate from the data processing device and contained within the storage cavity, the storage compartments each being configured to concurrently store a plurality of removable digital photo memory storage devices; and

a visual display device coupled to the case, the display device being configured to directly cover the storage cavity when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose a viewing screen when in an open, display mode wherein the electronic processing device is configured to receive at least one removable memory storage device and to process digital image data stored on the memory storage device and display said data on the visual display device.

Independent claim 14 substantially includes the elements of claims 1 and 5, including limitations with respect to simulation of a traditional photo album. Therefore, the arguments above for claims 1 and 5 apply with respect to claim 14. The combination of elements in claims 1 and 5 clearly differentiate over the prior art cited by the Examiner. Therefore, claim 14 is patentable for the reasons set forth for independent claim 1, as well as for the additional reasons set forth above.

Claim 15 substantially includes the elements of claim 2. Therefore, the arguments above for claim 2 apply with respect to claim 15.

Claim 16 substantially includes the elements of claim 10. Therefore, the arguments above for claim 10 apply with respect to claim 16.

Claim 17 substantially includes the elements of claim 11. Therefore, the arguments above for claim 11 apply with respect to claim 17.

Claim 18 substantially includes the elements of claim 5. Therefore, the arguments above for claim 5 apply with respect to claim 18.

Claim 19 substantially includes the elements of claim 3. Therefore, the arguments above for claim 3 apply with respect to claim 19.

Claim 20 substantially includes the elements of claim 6. Therefore, the arguments above for claim 6 apply with respect to claim 20.

Claim 21 substantially includes the elements of claim 4. Therefore, the arguments above for claim 4 apply with respect to claim 21.

Claim 22 substantially includes the elements of claim 7. Therefore, the arguments above for claim 7 apply with respect to claim 22.

In short, there is no motivation to combine components from Yamashita (having none of the claimed physical compartment structure or relation to photo images) with the ornamental designs disclosed in Parker for the reasons discussed above for claims 14-22. Moreover, even the combination of Yamashita and Parker does not provide the components required by claims 14-22 in the relationship required by claims 14-22 and the Examiner has identified no motivation for doing so. The Examiner has failed to establish a *prima facie* case of obviousness for claim 14-22.

CONCLUSION

In view of the foregoing, Appellants respectfully request the Board to overturn the Examiner's rejections of the appealed claims 1-22.

Dated this 24th day of August, 2004.

Respectfully submitted,



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APPENDIX: CLAIMS ON APPEAL

1. A container configured to electronically display images and simulate a photo album storage device, comprising:

a portable storage housing having a bottom and a plurality of upwardly extending sides, the upwardly extending sides defining at least one storage cavity portion within the storage housing, the at least one storage cavity portion being configured to concurrently store a plurality of removable digital memory storage devices;

a display cover coupled to the storage housing, the cover including a visual display device and being configured for open and closed positions to directly cover the storage cavity portion of the storage housing when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode; and

an electronic processing device, separate from the storage cavity portion and coupled to the storage housing and the visual display device, the processing device being configured to accept at least one of the plurality of removable memory storage devices and to process and display digital image data contained on the storage device.

2. A container as in claim 1, further comprising a navigation data entry interface and navigation control circuitry, each operatively coupled to the processing device to enable an operator to manipulate the digital images stored on the at least one removable memory storage device contained in the processing device.

3. A container as in claim 1, further comprising a data transmission and reception system coupled to the electronic processing device, the transmission and reception system being configured to allow a user to electronically send and receive data to and from the electronic processing device.
4. A container as in claim 1, further comprising an image data information display, operatively coupled to the container, the information display being configured to communicate to the user information relating to the digital images contained on the removable memory storage device contained in the processing device.
5. A container as in claim 1, further comprising a plurality of storage compartments contained within the storage cavity portion, the storage compartments being configured to concurrently store a plurality of removable digital memory storage devices.
6. A container as in claim 1, further comprising a telephone communication system, coupled to the storage housing, the communication system being configured to be connectable to a telephone network to allow a user to telephonically communicate with others while viewing the digital image data displayed on the visual display screen.
7. A container as in claim 1, wherein the visual display device is configured for open and closed positions to cover the storage housing when in a closed, storage mode and to adopt a substantially vertical position when in an open, viewing mode.

8. A container configured to electronically display images and simulate a photo album storage device, comprising:
 - a portable storage housing having a bottom and a plurality of upwardly extending sides, the upwardly extending sides defining at least one storage cavity portion within the storage housing;
 - a plurality of storage compartments contained within the storage cavity portion, the storage compartments being configured to concurrently store a plurality of removable digital memory storage devices;
 - a display cover coupled to the storage housing, the display cover including a visual display device for displaying digital images and being configured for open and closed positions to directly cover the storage cavity portion of the storage housing when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose the visual display device at a viewing position when in an open, viewing mode;
 - a electronic processing device, coupled to the storage housing and the visual display device, the processing device being configured to accept at least one of the plurality of removable memory storage devices and to process and display digital image data stored on the memory storage devices;
 - a navigation data entry interface and navigation control circuitry, each operatively coupled to the processing device to enable an operator to manipulate the digital images stored on the at least one removable memory storage device contained in the processing device;

a data transmission and reception system coupled to the electronic processing device, the transmission and reception system being configured to allow a user to electronically send and receive data to and from the electronic processing device; and a telephone communication system, coupled to the storage housing, the communication system being configured to be connectable to a telephone network to allow a user to telephonically communicate with others while viewing the digital image data displayed on the visual display screen.

9. A container as in claim 8, wherein the navigation data entry interface further comprises at least one touch key button.
10. A container as in claim 8, wherein the navigation data entry interface further comprises a touchscreen interface on the visual display device.
11. A container as in claim 8, wherein the navigation data entry interface further comprises a remote navigation device in data communication with the navigation control circuitry, the remote navigation device being configured to enable a user to remotely navigate through the digital image data displayed on the visual display device.
12. A container as in claim 8, wherein the storage compartments further comprise storage sleeves hingedly coupled within the storage compartment, the storage sleeves being configured to each accept for storage a digital memory storage device.

13. A container as in claim 8, wherein the visual display device is configured for open and closed positions to cover the storage housing when in a closed, storage mode and to adopt a substantially vertical position when in an open, viewing mode.

14. A container configured to simulate a photo album storage device and to electronically display images, comprising:

an electronic data processing device configured to process and display digital image data;

a portable case encompassing the electronic data processing device, comprising upwardly and outwardly extending walls which extend vertically above and laterally beyond the electronic processing device to define a storage cavity;

a plurality of storage compartments, separate from the data processing device and contained within the storage cavity, the storage compartments each being configured to concurrently store a plurality of removable digital photo memory storage devices; [and]

a visual display device coupled to the case, the display device being configured to directly cover the storage cavity when in a closed, storage mode and to directly expose the storage cavity and allow access to the plurality of removable digital memory storage devices and directly expose a viewing screen when in an open, display mode, wherein the electronic processing device, is configured to receive at least one removable memory storage device and to process digital image data stored on the memory storage device and display said data on the visual display device.

15. The container as in claim 14, further comprising a navigation data entry interface and navigation control circuitry, each operatively coupled to the processing device to enable an operator to manipulate the digital images stored on the at least one removable memory storage device contained in the processing device.

16. The container as in claim 15, wherein the navigation data entry interface further comprises a touchscreen interface on the visual display device.

17. The container as in claim 15, wherein the navigation data entry interface further comprises a remote navigation device in data communication with the navigation control circuitry, the remote navigation device being configured to enable a user to remotely navigate through the digital image data displayed on the visual display device.

18. A container as in claim 14, further comprising a plurality of storage compartments, separate from the electronic data processing device and contained within the storage cavity portion, the storage compartments being configured to concurrently store a plurality of removable digital memory storage devices.

19. A container as in claim 14, further comprising a data transmission and reception system coupled to the electronic processing device, the transmission and reception system being configured to allow a user to electronically send and receive data to and from the electronic processing device.

20. A container as in claim 14, wherein the storage housing further includes a telephone communication system, configured to be connectable to a telephone network to allow a user to telephonically communicate with others while viewing the digital image data displayed on the visual display screen.
21. A container as in claim 14, further comprising an image data information display, operatively coupled to the container, the information display being configured to communicate to the user information relating to the digital images contained on the removable memory storage device contained in the processing device.
22. A container as in claim 14, wherein the display device is configured for open and closed positions to cover the storage housing when in a closed, storage mode and to adopt a substantially vertical position when in an open, viewing mode.